

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:
Bates et al.

§
§
§
§
§
§

Filed: May 3, 2001

Serial No.: 09/848,573

Group Art Unit: 3621

Confirmation No.: 6829

Examiner: Pierre E. Elisca

For: Systems and Methods for Operating Vending Machines

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office to fax number 571-273-8300 to the attention of Examiner Pierre E. Elisca, or electronically transmitted via EFS-Web, on the date shown below:

June 16, 2008 /Joseph Jong/
Date Joseph Jong

Dear Sir:

APPEAL BRIEF

Applicants submit this Appeal Brief to the Board of Patent Appeals and Interferences on appeal from the decision of the Examiner of Group Art Unit 3621 dated December 12, 2007, finally rejecting claims 1-7, 10, 13-15, 17 and 18. The final rejection of claims 1-7, 10, 13-15, 17 and 18 is appealed. This Appeal Brief is believed to be timely since it is transmitted by the due date of June 14, 2008, as set by the filing of a Notice of Appeal on April 14, 2008. The fee for filing an appeal brief in the amount of \$500 was previously paid on August 18, 2006.

Please charge the fee of \$10.00 for filing this brief to:

Deposit Account No. 09-0465 / ROC920010064US1.

TABLE OF CONTENTS

1.	Identification Page.....	1
2.	Table of Contents	2
3.	Real Party in Interest	3
4.	Related Appeals and Interferences	4
5.	Status of Claims	5
6.	Status of Amendments	6
7.	Summary of Claimed Subject Matter	7
8.	Grounds of Rejection to be Reviewed on Appeal	9
9.	Arguments	10
10.	Conclusion	13
11.	Claims Appendix	14
12.	Evidence Appendix	17
13.	Related Proceedings Appendix	18

Real Party in Interest

The present application has been assigned to International Business Machines Corporation, Armonk, New York.

Related Appeals and Interferences

Applicant asserts that no other appeals or interferences are known to the Applicant, the Applicant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

Claims 1-7, 10, 13-15, 17 and 18 are pending in the application. Claims 1-48 were originally presented in the application. Claims 49 and 50 have been added during prosecution. Claims 8, 9, 11, 12, 16, and 19-50 have been canceled without prejudice. Claims 1-7, 10, 13-15, 17 and 18 stand finally rejected as discussed below. The final rejections of claims 1-7, 10, 13-15, 17 and 18 are appealed. The pending claims are shown in the attached Claims Appendix.

Status of Amendments

All claim amendments have been entered by the Examiner, including amendments to the claims proposed after the final rejection.

Summary of Claimed Subject Matter

Claimed embodiments include methods (see claims 1-7, 10, 13-15, 17-18) directed to operating vending machines in a network where each vending machine is configured to send, receive and process signals carrying inventory, pricing, reservation and/or refund information.

A. CLAIM 1 – INDEPENDENT

Claim 1 recites a method of locating an item in a network of vending machines. See Application, 11:2-3. For an example of a network of vending machines, see Figure 2. The method comprises receiving, at a vending machine in the network of vending machines, a purchase order for the item. See 9:5, 11:3-4. The vending machine is configured to dispense at least one type of item when stocked with the at least one item. See 42:2-4.

The method also comprises in response to receiving the purchase order, transmitting a request for the item via a network connection established through a network interface of the vending machine. See 9:6-7, 60:18-20, and Figure 7.

The method further comprises receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item. See 9:7-9; 37:4-6; Figure 8. Also, the method comprises whereby a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine. See 93:1-7 and Figure 17, 1770.

B. CLAIM 17 - INDEPENDENT

Claim 17 recites a method of locating an item in a network of vending machines. See Application, 11:2-3; Figure 2. The method comprises receiving, at a vending machine in the network of vending machines, a purchase order for the item. See 9:5,

11:3-4. The vending machine is configured to dispense at least one type of item when stocked with the at least one item. See 42:2-4.

The method also comprises in response to receiving the purchase order, transmitting a request for the item to a control system configured to process item requests for a plurality of vending machines of the network of vending machines. See Figure 2, 202; Figure 9, 920. The method also comprises the request being transmitted via a network connection established through a network interface of the vending machine. See 11:3-6, 60:18-20 and Figure 7.

The method further comprises receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item. See 9:7-9; 37:4-6; Figure 8. Also, the method comprises whereby a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine. See 93:1-7 and Figure 17, 1770.

Grounds of Rejection to be Reviewed on Appeal

1. Rejection of claims 1-7, 10, 13-15, 17 and 18 are under 35 U.S.C. 102(e) as being anticipated by *Newell et al.* (U.S. Patent No. 5,159, 560, hereinafter, "*Newell*").

ARGUMENTS

1. Rejection of claims 1-7, 10, 13-15, 17 and 18 are under 35 U.S.C. 102(e) as being anticipated by *Newell*.

The Applicable Law

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Reference

Newell teaches a vending machine network which manages inventory, monitors system reliability, and collects customer payments into a central location. See *Newell*, col. 1, lines 6-11. *Newell* provides automatic inventory tracing for a carousel type vending machine (e.g. a videocassette dispenser) network. The system includes means for tracking which inventory items are in stock, means for monitoring operational characteristics of the vending machine, and means for tracking and reporting billing information. See col. 3, lines 51-55. Specifically for the tracking of inventory items, *Newell* provides a means for where one item rented from one machine can be returned to another. See col. 5, lines 2-5. *Newell* teaches updating inventory reports for each vending machine. For example, when one item rented from one machine is returned to another, it must be removed from the inventory record of the vending machine it was rented from. See col. 4, lines 30-35. One method for tracking the items includes encoding each item with a bar code. See col. 9, lines 44-47. Items can be added to the inventory by scanning the bar code of the item at a vending machine. See col. 14, lines 10-20. Therefore, *Newell* is a system merely for tracking inventory of a vending

machine network, which does not require a method for "receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item, whereby a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine."

The Examiner's Argument

The Examiner argues that *Newell* teaches "receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item, whereby a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine" in the abstract, at col. 3, lines 42-67, col. 4, lines 30-59, col. 13 – col. 15, and col. 1, lines 40-53. See Final Office Action, pages 5-6. The Examiner argues that because *Newell* allows a number of vending machines, operating in diverse locations, to be used for dispensing and retrieving articles while allowing an article acquired from one vending machine to be returned to another in the system, it is **inherent** to recognize that the system in *Newell* is capable of checking availability of one other vending machine. See Final Office Action, page 6 (emphasis added).

Applicants' Response to the Examiner's Argument

In this case, *Newell* does not disclose "each and every element as set forth in the claim". Applicants have argued that *Newell* does not disclose "receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item, whereby a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine."

As an initial matter, Applicants state that the Examiner relies on inherency to reject claims 1-7, 10, 13-15, 17 and 18 under 35 U.S.C. 102(e), thereby acquiescing to the fact that *Newell* does not explicitly teach each of the elements of the claims. Applicants point out that the fact that a certain result or characteristic may occur or be present in

the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). *See MPEP* Sec. 2112. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). *See id.*

In this case, it does not follow that the system in *Newell* is inherently capable of checking availability of one other vending machine. *Newell* merely updates the location of the item in the networked inventory when an item is returned to a machine. *See Newell*, col. 4, lines 57-59 (scanning bar code of returned item to update inventory files); col. 5, lines 2-5 (method for acquiring a videotape from one vending machine and returning it to another whereby the system tracks the actual location of the videotape); col. 14, lines 11-18 (user adding tape to vending machine updates inventory file). There is no mechanism in *Newell* by which a vending machine receives "a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item." Even assuming the network in *Newell* knows which vending machine the item (e.g. videocassette) is located at (i.e. check availability), the vending machine in *Newell* does not give the user information by which "a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine."

Additionally, *Newell* does not disclose "in response to receiving the purchase order, transmitting a request for the item via a network connection established through a network interface of the vending machine." Applicant points out that the Examiner provides no citation to *Newell* for teaching this element.

Therefore, the Examiner has not met the burden to establish inherency, because the Examiner has not made it clear that the missing descriptive matter is necessarily present in *Newell*, and that it would be so recognized by persons of ordinary skill.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

CONCLUSION

The Examiner errs in finding that claims 1-7, 10, 13-15, 17 and 18 are being anticipated by *Newell*.

Withdrawal of the rejection and allowance of all claims is respectfully requested.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

/Gero G. McClellan, Reg. No. 44,227/

Gero G. McClellan
Registration No. 44,227
Patterson & Sheridan, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Appellant(s)

CLAIMS APPENDIX

1. (Previously Presented) A method of locating an item in a network of vending machines, comprising:

receiving, at a vending machine in the network of vending machines, a purchase order for the item, the vending machine being configured to dispense at least one type of item when stocked with the at least one item;

in response to receiving the purchase order, transmitting a request for the item via a network connection established through a network interface of the vending machine; and

receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item, whereby a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine.

2. (Previously Presented) The method of claim 1, further comprising outputting to the user, from an output device of the vending machine, an indication of the availability of the item at the at least one other vending machine.

3. (Previously Presented) The method of claim 1, wherein the transmitting comprises transmitting the request to the at least one other vending machine.

4. (Previously Presented) The method of claim 1, further comprising prior to transmitting, determining, by the vending machine, the availability of item at the vending machine, and if the item is not available at the vending machine, then transmitting the request.

5. (Previously Presented) The method of claim 1, wherein the receiving the response comprises receiving the response from the at least one other vending machine.

6. (Original) The method of claim 1, wherein receiving the response comprises receiving the response from a control system configured to process item requests for a plurality of vending machines of the network of vending machines.
7. (Original) The method of claim 1, further comprising outputting to an output device a message indicating whether the item was located at the at least one other vending machine and, if so, indicating a location of the at least one other vending machine.
- 8-9. (Canceled)
10. (Original) The method of claim 1, further comprising:
receiving, at the vending machine, a payment amount for the item; and
receiving an electronic refund request for the purchase order.
- 11-12. (Canceled)
13. (Original) The method of claim 10, further comprising refunding the payment amount if customer information received through the network connection satisfies refund conditions.
14. (Original) The method of claim 13, wherein the refund conditions comprise a threshold number of purchases made by a requestor of the refund.
15. (Previously Presented) The method of claim 1, further comprising:
if the item is available at the at least one other vending machine, determining whether a price adjustment is necessary for the item;
if a price adjustment is determined to be necessary, adjusting a price for the item;
and
displaying the adjusted price to the user.
16. (Canceled)
17. (Previously Presented) A method of locating an item in a network of vending machines, comprising:

receiving, at a vending machine in the network of vending machines, a purchase order for the item, the vending machine being configured to dispense at least one type of item when stocked with the at least one item;

in response to receiving the purchase order, transmitting a request for the item to a control system configured to process item requests for a plurality of vending machines of the network of vending machines, the request being transmitted via a network connection established through a network interface of the vending machine; and

receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item, whereby a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine.

18. (Original) The method of claim 17, further comprising, determining, by the control system, whether any of a plurality of vending machines of the network of vending machines has the item.

19-50. (Canceled)

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.